

PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number: 042933/270321

(filed with the Notice of Appeal)

Application Number: 10/715,790

Filed: November 18, 2003

First Named Inventor: Deeds

Art Unit: 2617

Examiner: A. Balaoing

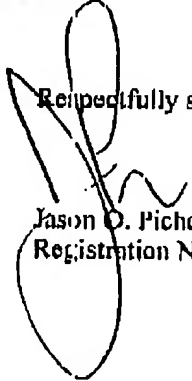
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



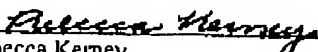
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.



Rebecca Kerney

6/30/06
Date

I. Independent Claims 1, 21, and 41 (and claims depending therefrom)

- A. The Examiner has failed to consider the references as a whole, as required by MPEP 2141.02(VI), when considering what a skilled artisan would take therefrom.

Independent Claims 1, 21, and 41 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application No. 2003/0169460 to Liao *et. al.* ("Liao"). The Office Action indicates that it would be obvious to use the disclosure of Liao as motivation to visually represent the required bandwidth for transmitting and receiving signals on the current communications system in addition to the available bandwidth of the current communications system. The Office Action admits that Liao does not specifically disclose a display capable of visually representing the required bandwidth for transmitting and receiving signals on a communications system. However, the Office Action further states that: it would have been obvious ... to modify Liao to display the bandwidth determined necessary to transmit and receive signals, as Liao teaches calculating the bandwidth needed to transmit and receive via a communications system." Applicants respectfully submit that, in alleging obviousness, the Examiner is merely picking and choosing portions of Liao without properly considering what the reference teaches as a whole.

When viewed as a whole, Liao teaches away from the display of the required bandwidth for transmitting and receiving signals on the current communications system prior to modifying communications therewith. Specifically, there is no reason for the system disclosed in Liao to display the required bandwidth for transmitting and receiving signals on the current communications system prior to modifying communications therewith, because Liao discloses that the system performs an algorithm to allocate bandwidth among competing applications and may "automatically select for [bandwidth] upgrade the application that is most active in bandwidth usage." See Liao at paragraph 0054. Thus, Liao teaches away from displaying the required bandwidth (relative to the available bandwidth, for example) since the required bandwidth determination is disclosed in Liao as an intermediate step that leads to the "automatic" allocation of bandwidth among competing applications.

Accordingly, Applicants respectfully submit it is improper for the Examiner to rely on the disclosure of the determination of a required bandwidth while ignoring the specific and unambiguous teachings of Liao to use the bandwidth determination as an intermediate step that leads not to a display of the required bandwidth, but to an "automatic" allocation of bandwidth among competing applications. The specific display capable of visually representing a required bandwidth is a clearly recited element of the presently claimed invention, and Applicants respectfully submit the Examiner

has failed to consider the entirety of the teachings of Liao as they pertain to the preferred use of the determined bandwidth to automatically allocate bandwidth among competing applications without displaying an indication of the determined bandwidth to a user.

Similar arguments can also be made for the remaining references used to reject Claims 3, 5, 10-12, 15, 16, 23, 25, 30-32, 35, 36, 43, 45, 50-52, 55 and 56, which each depend from, and include all of the limitations of at least one of Claims 1, 21, and 41. None of the cited Ko, Arsenault, Rosenfeld, Zanchi or Watanabe references teaches or suggests a display capable of visually representing a required bandwidth. Thus none of the cited references serve to contradict the teachings of Liao as a whole which indicate that the determination of required bandwidth as an intermediate step that leads not to a display of the required bandwidth, but to an "automatic" allocation of bandwidth among competing applications.

B. The Examiner has failed to show suggestion in the cited references, as required by MPEP 2143.01(I), for modifying the references to arrive at the presently claimed invention.

The Office Action admits that "Liao does not specifically disclose wherein the display is further capable of visually representing the required bandwidth for transmitting and receiving signals on the current communications system." However, the Office Action alleges that motivation to modify Liao may be inferred as follows: "This is beneficial in that manual adjustment of bandwidth usage can be determined by the visual display." However, as discussed herein, Liao specifically teaches away from manual adjustment of bandwidth usage. Liao discloses that "the cellular phone may automatically select for upgrade the application that is most active in bandwidth usage." In other embodiments, Liao discloses that "a suitable screen may pop up listing the currently running applications and prompting the user to select one of the applications for a bandwidth upgrade." See Liao, at paragraph 0054. In both of these disclosed embodiments, however, Liao includes no objective teaching for displaying the required bandwidth for transmitting and receiving signals, and instead repeatedly discloses various concepts for selecting an "application" (either "automatically" or via a user selection of such an application) for an allocation of additional bandwidth and updating a display to indicate the additional bandwidth made available by such an allocation. See Liao, at paragraph 0055. Thus, Liao teaches away from the "beneficial" aspects of the proposed modification to Liao that results in the pending rejections of independent Claims 1, 21, and 41 and further contains no objective teaching or suggestion to display the "required bandwidth" for transmitting and receiving signals via a current communications system.

Thus, the Applicants respectfully submit that the Examiner has failed to show suggestion in the cited references, as required by MPEP 2143.01(I), for modifying the references to arrive at the presently claimed invention.

- C. The Examiner is relying upon impermissible hindsight in modifying the references to arrive at the presently claimed invention.

Applicants further respectfully submit that the rejections of Claims 1, 21, and 41 are the result of the improper use of hindsight to modify Liao in light of the disclosure of the present application. As already pointed out, the Examiner has failed to consider the teaching of the references as a whole, and has failed to show proper suggestion for modifying the cited references. Accordingly, it seems apparent that the Examiner is relying upon impermissible hindsight to modify the references and arrive at the presently claimed invention.

II. Independent Claims 17 and 37 (and claims depending therefrom)

- A. The Examiner has failed to consider the references as a whole, as required by MPEP 2141.02(VI), when considering what a skilled artisan would take therefrom.

Claims 17 and 37 (and Claims 18 and 38, depending respectively therefrom) stand rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of U.S. Patent No. 6,233,469 to Watanabe ("Watanabe"). Each of Claims 17 and 37 specifically recite a second terminal comprising a display capable of visually representing an available bandwidth of a communications system utilized by a first terminal. The Office Action states that "both [Liao and Watanabe] disclose displaying data to users on a portable communications device, therefore it would have been obvious to a person of ordinary skill in the art to modify Liao to include the teachings of Watanabe, as it would provide a user with a better view of the display during calls."

However, as discussed herein, the Examiner has once again failed to consider the teachings of the references as a whole. For example, the fact that the apparatus disclosed in Watanabe provides a user with a better view of the display (via a sliding display) during calls does not, on its own, suggest the desirability of the combination of Watanabe's teachings with that of Liao, as Liao teaches that "the cellular phone may automatically select for upgrade the application that is most active in bandwidth usage." See Liao, at paragraph 0054. Watanabe contains no suggestion of the desirability of tracking bandwidth at all (as it is concerned only with the visibility of the display while the terminal is in use), and Liao, when viewed as a whole, suggests that bandwidth tracking should result in the automatic selection of an application that is most active in bandwidth usage for a bandwidth reallocation (thereby negating the need to view a bandwidth display, as such bandwidth tracking and

reallocation may be transparent to a user). Thus, for at least the reasons stated above, the Applicants respectfully submit that the Examiner has failed to consider the references as a whole, when considering what a skilled artisan would take therefrom.

- B. The Examiner has failed to show suggestion in the cited references, as required by MPEP 2143.01(I), for modifying the references to arrive at the presently claimed invention.

The only alleged "objective teaching" presented in the Office Action to combine the teachings of Liao and Watanabe is that the proposed combination "would provide a user with a better view of the display during calls." As discussed herein, the fact that the apparatus disclosed in Watanabe provides a user with a better view of the display during calls does not, on its own, suggest the combination of Watanabe's teachings with that of Liao, as Liao teaches that "the cellular phone may automatically select for upgrade the application that is most active in bandwidth usage." See Liao, at paragraph 0054. Watanabe contains no suggestion of the desirability of tracking bandwidth at all, and Liao suggests that bandwidth tracking should result in the automatic selection of an application that is most active in bandwidth usage (thereby negating the need to view a display at all). Therefore, for at least the reasons stated above, the Applicant's respectfully submit that the Examiner has failed to show suggestion in the references for modifying the references to arrive at the invention specifically recited in Claims 17 and 37.

- C. The Examiner is relying upon impermissible hindsight in modifying the references to arrive at the presently claimed invention.

Applicants further respectfully submit that the rejections of Claims 17 and 37 are the result of the improper use of hindsight to combine Liao and Watanabe in light of the disclosure of the present application. The only "objective teaching" alleged by the Examiner to modify Liao to include the slidable display of Watanabe presented in the Office Action is that the proposed combination "would provide a user with a better view of the display during calls." This advantage is only suggestive of the proposed combination of the cited references when viewed in light of the disclosure of the present application. Such a "suggestion" requires the use of improper hindsight. As already pointed out, the Examiner has failed to consider the teaching of the references as a whole, and has failed to show proper suggestion for modifying and/or combining the cited references. Accordingly, it seems apparent that the Examiner is relying upon impermissible hindsight to modify the references and arrive at the presently claimed invention.

In light of all of the above reasons, Applicants respectfully submit that maintenance of the rejections is improper. Therefore, Applicants respectfully request withdrawal of the rejections and allowance of the present claims.